

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

EXPRESS MOBILE INC.,
Patent Owner

Case IPR2022-00597

U.S. Patent No. 7,594,168 B2
Issue Date: September 22, 2009

Title: Browser Based Web Site Generation Tool and Run Time Engine

**PETITIONER'S REPLY
IN SUPPORT OF MOTION FOR JOINDER**

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Google LLC ("Google") respectfully submits this Reply to Express Mobile Inc.'s ("Express Mobile") Opposition to Motion for Joinder (Paper 8, "Opp.").

I. The Petition is Not Time-Barred

Express Mobile asserts that "the petition is time-barred" (Opp., 3), and accuses Google of a lack of candor of this purported time bar (Opp., 8-9). This is false. 35 U.S.C. § 315(b) recites:

[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. *The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).*

35 U.S.C. § 315(b) (emphasis added). Thus, § 315(b) makes clear that a petition that accompanies a request for joinder under § 315(c) is exempted from the time limitation on the filing of a petition. Indeed, Express Mobile itself recognizes this exception. (Opp., 4 ("The only exception to the statutory § 315(b) bar is the joinder exception in § 315(c).").) And Express Mobile does not dispute that this exception applies here, where the Petition was filed concurrently with a Motion for Joinder to IPR2021-01226. Express Mobile's argument thus lacks any merit whatsoever.

Express Mobile also suggests that the Board should side-step the exception to § 315(b) established by Congress by yielding the Board's discretion on whether to institute. (Opp., 7-9.) For instance, in addition to its false assertion regarding

Google's candor, Express Mobile asserts that Google "does not explain why it could not have filed an IPR petition concurrently with the petition it filed against one of its fellow patents-in-suit" in IPR2021-00700. (Opp., 8 (quotation marks omitted).) Express Mobile's suggestion is baseless and unsupported. In any event, Google hereby represents that, at the time of filing of the petition in IPR2021-00700, counsel for Google in any of the actions involving Express Mobile did not identify or consider the prior art used in the Facebook IPR proceeding and in the present proceeding, despite extensive prior art search.

II. *Uniloc* and *Proppant* Do Not Support Denial of Joinder and Institution

Contrary to Express Mobile's suggestion, the Board's precedential decisions in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) ("*Uniloc*") and *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38, 18 (Mar. 13, 2019) ("*Proppant*") are inapplicable to the present proceeding, where the Petition is Google's first challenge to the '168 patent (unlike in *Uniloc*), and Google does not request same party joinder of new issues (unlike in *Proppant*).

In *Uniloc*, the Board explained that "[u]nder 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director's determination that the petition warrants institution," which is not limited to determining the strength and merit of the petition's showing of unpatentability, and

includes determining whether to exercise discretion under 35 U.S.C. § 314(a) to deny institution. *Uniloc* at 5. Thus, the Board in *Uniloc* held that before determining joinder of a “me-too” petition, the Board should “first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).” *Id.* In *Uniloc*, the Board found that the *General Plastic* factors weighed against institution of petitioner’s “me-too” petition because it was the petitioner’s second challenge of the patent and the petitioner did not provide any explanation with respect to the *General Plastic* factors. *Id.*, 5-13. Here, unlike in *Uniloc*, the Petition is Google’s first challenge of the ’168 patent. Thus, the *General Plastic* factors are not implicated and do not weigh against institution under § 314(a). *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (Sept. 6, 2017) (precedential) (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

Express Mobile argues that *Uniloc* should nonetheless apply, even though Google never previously challenged the ’168 patent, because “[i]t must be assumed that” Google “kn[e]w of the art in Facebook’s case.” (Opp., 6 (citing *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17, 10-12 (June 10, 2021)).) Express Mobile uses selective quotation to suggest that *HTC* involved a case where the petitioner had not previously challenged the patent. (Opp., 6 (referring to how the “joinder petitioner ‘had the opportunity [years earlier] to file an *inter partes* review

petition”).) Express Mobile fails to mention that in *HTC*, the petitioner had previously filed a petition for CBM review, and the Board found that the petitioner “should have known [about the prior art references] when filing its first petition.” *HTC* at 9.

Proppant likewise does not support denial of joinder. In *Proppant*, the petitioner sought joinder to its own *inter parte* review to correct an error in the first petition. *Proppant* at 2. The Board in *Proppant* held that “§ 315 (c) provides discretion to allow a petitioner to be joined to a proceeding in which it is already a party and provides discretion to allow joinder of new issues into an existing proceeding.” *Id.* at 4. In the context of such same-party, new-issue joinder, which has since been rejected in *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321 (Fed. Cir. 2020), the Board explained that whether petitioner is otherwise “time bar[red] under § 315 (b) is one of several factors that may be considered.” *Id.*; see also *id.* at 19. Accordingly, the Board in *Proppant* denied petitioner’s request for same party joinder of new issues, because petitioner was otherwise time-barred and petitioner’s “own conduct created the need for it to request joinder.” *Id.* at 19-20. Here, Google requests joinder to a proceeding filed by a different party (Facebook, Inc.) involving substantively identical issues. Thus, unlike *Proppant*, this case involves neither same party joinder nor new-issue joinder.

III. Joinder Will Not Complicate the Proceedings

Express Mobile argues that Google's pledge to participant as an "understudy" has many caveats that potentially allows Google to assume an "active role." (Opp., 9-10.) To the extent the Board finds Google's conditions for accepting the "understudy role" to be overbroad, Google is "willing to agree to any other reasonable conditions the Board deems necessary," as set forth in Google's Motion for Joinder. (Mot., 13.) Accordingly, joinder will not complicate the proceeding.

IV. Conclusion

For reasons discussed above and in Google's Motion for Joinder, Google respectfully requests that the Board institute review and grant joinder.

Respectfully submitted,

Dated: May 2, 2022

By: /Naveen Modi/

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CERTIFICATE OF SERVICE

I hereby certify that on May 2, 2022, I caused a true and correct copy of the foregoing Reply in Support of Motion for Joinder to be served via express mail on the Patent Owner at the following correspondence address of record as listed on PAIR:

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